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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,183	11/27/2006	Takakazu Shiomi	P30534	1989
52123	7590	12/10/2009		
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER				
LAY, MICHELLE K				
ART UNIT		PAPER NUMBER		
2628				
NOTIFICATION DATE		DELIVERY MODE		
12/10/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/598,183

Applicant(s)

SHIOMI ET AL.

Examiner

MICHELLE K. LAY

Art Unit

2628

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/8)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

The amendment filed 08/06/2009 has been entered and made of record. Claims 1-19 are cancelled. Claims 20-22 are pending.

The amendment to the abstract has overcome the objection to the specification made in the Non-Final office action filed 05/12/2009.

The cancellation of claim 13 has overcome the 35 USC 101 rejection made in the Non-Final office action filed 05/12/2009.

Response to Arguments

Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 21 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither

transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. The Applicant has provided no explicit and deliberate definitions of the steps recited in claim 21 to limit the steps to an electronic form.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims **20-22** are rejected under 35 U.S.C. 102(a) as being anticipated by Matsumoto et al. (2003/0080958).

In regards to claim **20**, Matsumoto teaches an image generating apparatus that superimposes a plurality of layers for display. Matsumoto teaches a program storage device readable by a computer for tangibly embodying a program of instructions executable by the computer to perform an image generating method [0043]. The program can be downloaded through a communication device (said **downloader operable to download the program**) and then executed via the image generating apparatus (said **executioner**) [0044]. The image generating apparatus (1) is provided

with a drawing application processor (11), a graphics library (12), a drawing device (13), a graphics memory (16) and a superimposing unit (17) [Fig. 1; 0068]. The image generating apparatus (1) is designed so as to be able to generate images of the plurality of layers. In order that the drawing device (13) generates a 3D image of the first layer, a first frame buffer (16a) is installed within the graphics memory (16). In order to generate a 3D image of the second layer, a second frame buffer (16b) is installed within the graphics memory (16). Namely, the frame buffers whose number is corresponding to the number of the layers are installed within the graphics memory (16) (said **a provider operable to provide ... plurality of storage areas**) [0069]. With reference to Fig. 3, the drawing application processor (11) generates a display list for a 3D image. The generated display list is stored as an object display list (1) of the graphics library (12) (said **an order storage**) [0079]. The display list execution device (123) (said **notifier**) controls the drawing device (13). When generating the 3D image, the display list execution device (123) instructs the scene object setting device (121) and the display list arranging device (122) to send the coordinate transformation information and the arrange or reconstructed display list (said **notification regarding the order stored**) to the drawing device (13) and further instructs the drawing device (13) to execute the image generating process [0076]. If the arranging or reconstruction of the display list is indicated, the display list received from the drawing application processor (11) is arranged or reconstructed (said **graphic image is overwritten according to order**) so as to be suitable for the drawing device (13) [0083]. The multiple layers within the multiple frame buffers (16a, b ...) are configured so as to be displayed on and outputted

as one multiple-layer 3D image to a display unit, after they are superimposed by the superimposing unit (17) (said **a display operable to superimpose**) [0069; 0078]. Furthermore, as shown in Fig. 1, the system of Matsumoto teaches the different layers comprising the superimposed image are stored in a first frame buffer (16a), second frame buffer (16b) ... n frame buffer, depended on the n number of layers. The generated display list provides the order in which the layers will be superimposed in [0079]. Thus, the different layers are stored in the order in which the layers will be superimposed as indicated by the display list (said **graphics images stored in storage areas in accordance with order storage**).

In regards to claim **21**, claim 21 recites similar limitations as claim 20 but in process form. Therefore, the same rationale used for claim 20 is applied. Furthermore, Matsumoto teaches the process implemented by the system described in the rationale of claim 20 within Fig. 3 [0079].

In regards to claim **22**, claim 22 recites similar limitations as claim 20 but in manufacture form. Therefore, the same rationale used for claim 20 is applied. Furthermore, Matsumoto teaches the program storage device (said **computer readable storage medium**) readable by a computer for tangibly embodying a program of instructions executable by the computer to perform an image generating method [0043].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle K. Lay whose telephone number is (571) 272-7661. The examiner can normally be reached on Monday-Friday 7:30a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee M. Tung can be reached on (571) 272-7794. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michelle K. Lay/
Examiner, Art Unit 2628
December 4, 2009